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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/812,454 | 03/30/2004 | Koujiro Kameyama | I4225-046001 / F1040123US | 3138 |
| 26211 | 7590 | 01/24/2006 | EXAMINER | |
| FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022 | | | MONDT, JOHANNES P | |
| | | | ART UNIT | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.



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| APPLICATION NO./ CONTROL NO. <u>10/812,454</u> | FILING DATE <u>3/30/04</u> | FIRST NAMED INVENTOR / <u>K. KAMEYAMA</u> PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. <u>14225-046001/F10401234500</u> |
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EXAMINER

J. MONDT

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| ART UNIT | PAPER |
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Commissioner for Patents

Receipt is acknowledged of an Amendment received 11/14/05. However, the submission is not fully responsive to the prior office action because the newly submitted claims are directed to an invention that is independent and distinct from the originally claimed invention for the following reasons: The new invention is directed towards a different species (Species of Figure 1B) (note limitation on penetrating region extending from the front surface to a back surface of the semiconductor element in a manner substantially vertical to the front and back surfaces of the semiconductor element, wherein the penetrating region is located over the first conductive means and away from side surfaces of the semiconductor element; a second conductive means located inside the penetrating region and electrically connected to the first conductive means". Said Species of the embodiment of Figure 1B is patentably distinct and mutually exclusive from the Species of Figure 1A as claimed in the original claims (see the limitation in claim 5, "the circuit portion of the optical semiconductor element and the terminal portion are connected through a rewiring pattern elongating along a side surface portion of the optical semiconductor element, and the rewiring pattern is covered with the sealing resin"). Please note that the two Species of Figure 1A and 1B are mutually exclusive because either the rewiring pattern is along a side (Species of Figure 1A) or its penetrates in a substantially vertical manner (Species 1B). The two inventions, i.e., the originally claimed and newly claimed invention, relate as species because nothing in the originally claimed invention implies the claim limitations in the newly claimed invention, vice versa: all original claims read on the Species of Figure 1A and none of the original claims exclusively reads on the Species of Figure 1B. In contrast, all claims in the amendment exclusively read on the Species of Figure 1B. Since Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original representation for prosecution on the merits. Accordingly, claims 18-22 are withdrawn from consideration as being directed to a non-elected invention. See 37 C. F.R. 1.142(b) and MPEP, paragraph 821.03. Therefore, since there are no pending claims drawn to the originally examined invention, the submission must be considered non-responsive. Because the above-mentioned reply appears bona fide, Applicant is given ONE (1) MONTH OR THIRTY (30) DAYS from the mailing date of this Notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 C.F.R 1.136(a).

JPM
01/15/06

Art Unit: 3663

Patent Examiner:

Johannes Mondt